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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,675	10/02/2000	Frank Hagebarth	Q60673	4764

7590 11/22/2004

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EXAMINER	
ODLAND, DAVID E	
ART UNIT	**PAPER NUMBER**
2662	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/676,675	HAGEBARTH, FRANK	
	Examiner	Art Unit	
	David Odland	2662	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: *6 and 7*.

   Claim(s) rejected: *1-5 & 8-19*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____

10. ☐ Other: _____

JOHN PEZZLO
PRIMARY EXAMINER

Continuation of 2a: The applicant has amended claims 18 and 19 by adding some of the limitations of their related independent claims 1 and 12, however, since not *all* of the limitations in the independent claims have been added to claims 18 and 19 the scope of these claims has changed. The After Final amendment will not be entered because this change in scope raises new issues that would require further search and/or consideration.

Continuation of part 5c: the Applicant's arguments are not persuasive.

On page 15 last paragraph regarding claim 1, the Applicant argues that the subscriber node in McMullen is already activated and thus there is no activation of an inactive terminal, as required by the claim. The Examiner respectfully disagrees. The term 'activate' is a broad term and the claim does not specify exactly what aspect of the terminal is being activated. In McMullen, the computer activates a notification procedure when an incoming call comes in from the proxy. Thus this activation of the notification process can be considered 'activating an inactive terminal'.

On page 16 last paragraph the Applicant contends that in claim 1 "...prior to establishing the connection, the server terminates the telephone call to the server..." and that this differs from the McMullen reference. However, the claim does not recite that the method is performed in this precise order. Namely, the claim recites in the last two steps that the server terminates the call to the terminal and that the terminal establishes a connection to the data network, but with the way the clam is written there is no requirement that these two steps happen in this particular order. In McMullen, the subscriber establishes a call over the data network and then the proxy terminates the call to the subscriber. It is suggested by the Examiner that the Applicant reword the claim to

reflect that the server terminates the call to the terminal prior to establishing the connection with the data network, if this is indeed what is performed by the invention. The Applicant goes on to argue that since the subscriber is already connected to the Internet, there is no establishment of a connection needed. The Examiner respectfully disagrees. Although the computer is connected to the Internet, this does not mean that the computer is connected to and communicating with the caller that wishes to speak with the user of the computer. In this case, a connection is established (i.e. signaling information for the call is transferred) from the particular caller and the telephone call can proceed.

On pages 18 and 19, regarding claims 12 and 15, the Applicant contends that the computer is not connected between the subscriber and the telephone and that the adaptor is not "in" a telephone. The Examiner respectfully disagrees.

In response to applicant's arguments, the recitations "An adaptor unit (9) connected between a terminal (5;6) of a telephone network (4) and the telephone network (4)..." (from claim 12) and "an adapter unit (9;10) is incorporated in the telephone (5,6)..." (from claim 15) have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, even if they were given patentable weight, the subscriber can be considered the person using the computer and so the computer would be connected between the user of the computer and the network. Also, the NIC

that is inside the computer can be considered the adapter unit and thus it would be considered as being 'between' the subscriber computer and the network. Thus as currently written the McMullen reference reads on the claimed invention.